

IN THE CLAIMS: See Listing of Claims. This listing will replace all prior versions of claims in the application.

REMARKS

The Applicants acknowledge the Examiner's comprehensive Office Action with appreciation. The Office acknowledges that Claims 1-19 were cancelled in a preliminary amendment. The Office narrows the previously issued Restriction Requirement. Claims 20-40 remain pending in the application; however, Claims 34, 35, 36, 38, and 39 have been withdrawn from consideration as a result of the Restriction Requirement. The Office raises rejections under 35 USC § 112, first paragraph. The Office also raises objections as to form.

The Office acknowledges the claim to priority in that the instant application is a 35 USC § 371 national phase application claiming benefit from PCT international application PCT/FR03/03278, filed on November 4, 2003. The Applicants note that a typographical error exists in the Office Action relating to the convention priority claim. The Office Action notes the convention priority claim to FRANCE 02/13197; however, FRANCE 02/13917 was claimed upon filing.

The Office acknowledges the Information Disclosure Statement (Form PTO-1449) submitted on May 5, 2005 and indicates that the IDS was missing a copy of reference EP 0919541. In response thereto, the Applicants submit the previously cited reference, EP 0919541, along with Form PTO-1449. Consideration of the cited reference is respectfully solicited.

The Office acknowledges the oath or declaration submitted on May 5, 2005; however, the Office indicates that the oath or declaration is defective because it does not identify the citizenship of each inventor. In compliance with 37 CFR § 1.67(a), a replacement declaration is submitted herewith. Entry of the replacement declaration is respectfully solicited.

The Office acknowledges the Applicant's election ***with traverse*** to prosecute the proposed Restriction Group directed to compounds wherein A represents

-N(R₂)COR₁; however, the Office further limits the definition of A by excluding the alternatives heteroaryl and heteroaryl-(C₁-C₆alkyl) from the definition of R₁. It is the position of the Office that such heteroaryl compounds are structurally distinct from the compounds encompassed by the remaining alternatives in the R₁ definition.

The Office states that when R₁ is heteroaryl, the classification of the claimed compound is controlled by the heteroaryl group and that different search considerations are involved (such as class/subclass searches, etc.) depending on the choice of heteroaryl group. It is the position of the Office that a search of the invention encompassing all the compounds defined by the proposed restriction group would constitute an undue burden on the Office.

The Applicants respectfully submit that the fact that a "heteroaryl group" may be classified under different classes/subclasses does not demonstrate that one skilled in the chemical arts would recognize different heteroaryl groups to be structurally distinct. A "Field of Search" listing on nearly any US patent lists at least five or ten different class/subclass combinations, any number of which are relevant to the invention covered in that patent. Thus, a patent with claims directed to compounds comprising different heteroaryl substituents may be assigned an original classification and be cross-referenced in other classes listed by the Examiner.

Moreover, under current Office Markush practice, the Office is obligated to expand, rather than narrow, restriction groups in the absence of identifying art which would demonstrate that patentably distinct groups exist. Therefore, reconsideration and withdrawal of the further narrowing of the definition of A, at least, is respectfully solicited.

Claims 37 and 40 are rejected for lack of enablement under 35 USC § 112, first paragraph. It is the position of the Office that the claims contain subject matter which was not described in the specification, specifically, identifying melatoninerbic diseases and disorders that can be treated by using the product of Claim 20. With the instant amendment, Claim 37 has been amended to delete the language "useful for treating melatoninerbic disorders" since such functional language is not

considered by the Office to have any patentable relevance in pharmaceutical composition claims. With respect to Claim 40, the Applicants note that this claim is directed to non-elected subject matter and, as a result, Claim 40 should be withdrawn from consideration. Reconsideration and withdrawal of the lack of enablement rejection is respectfully solicited.

Claims 20-33, 37 and 40 are objected to as containing non-elected subject matter. With the instant Amendment, the Applicants have cancelled the non-elected subject matter without prejudice to its prosecution in a Divisional Application. Reconsideration and withdrawal of the objection is respectfully requested. Moreover, pursuant to MPEP § 821.4, the Applicants assert their right of rejoinder of method Claims 35 and 36 commensurate in scope with allowable substance claims.

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Accordingly, entry of the present Amendment into the record of this application, reconsideration of all grounds of objection and rejection, withdrawal thereof, rejoinder of method claims, and passage of this application to issue are all hereby respectfully solicited.

It should be apparent that the undersigned agent has made an earnest effort to place this application into condition for immediate allowance. If she can be of assistance to the Examiner in the elimination of any possibly-outstanding insignificant impediment to an immediate allowance, the Examiner is respectfully invited to call her at her below-listed number for such purpose.

Allowance is solicited.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

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Enclosure: Replacement Declaration; EP 0919541 Reference along with Form
PTO-1449; Check No. 75592 for One (1) Month Extension Fee; Listing
of Claims and Postal Card Receipt

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